

ATTENTION: BOX AFTER FINAL
EXPEDITED PROCEDURE REQUESTED
EXAMINING GROUP 1751



PATENT
Customer Number 22,852
Attorney Docket No. 5725.0555-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re National Stage of International Application No.: PCT/FR98/01591 of:)

Mireille MAUBRU et al.) Group Art Unit: 1751

Application No.: 09/486,558) Examiner: M. EINSMANN

PCT Filed: July 20, 1998)

National Stage Entry: February 29, 2000)

For: DYEING COMPOSITION FOR KERATIN FIBRES)

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

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RESPONSE

The final Office Action dated June 14, 2001, has been received and its contents carefully considered. A one month extension of time, extending the response date through October 14, 2001, is being filed concurrently herewith. Applicants note, with appreciation, the Examiner's withdrawal of rejections over U.S. Patent No. 5,766,576 to Lowe et al. The remaining rejections are addressed below.

1. Status of the Claims

Claims 20-47 are pending in this application. No claims have been amended.

2. Rejection Under 35 U.S.C. §103

Claims 20-47 were rejected under 35 U.S.C. §103.

In order to establish a *prima facie* case of obviousness, the Office must provide evidence of (1) a suggestion or motivation to combine the references, (2) a reasonable expectation of success for the proposed combination, and (3) a teaching or suggestion of all the claimed elements. M.P.E.P. §2143.

More specifically, the proposed combination or modification cannot change the principle of operation of a reference. In fact, section 2143.01 of the M.P.E.P., citing *In re Ratti*, 123 U.S.P.Q. 349 (CCPA 1959), specifically states that “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious.”

Further, if a reference teaches away from the claimed invention, this alone will defeat a *prima facie* case of obviousness. See *Winner International Royalty Corp v. Wang*, 53 USPQ2d 1580, 1587 (Fed. Cir. 2000). In other words, “[t]here is no suggestion to combine, . . . if a reference teaches away from its combination with another source.” *Tech Air Inc. v. Denso Manufacturing Michigan Inc.*, 52 USPQ2d 1294, 1298 (Fed. Cir. 1999).

Claims 20 - 47 were rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 3,918,896 to Kalopassis et al. (Kalopassis) in view of U.S. Patent No. 5,061,289 to Clausen et al. (Clausen). Applicants reiterate their traversal for the reasons of record and for the reason that the Office's proposed combination is directly contrary to the express teachings of the primary reference, Kalopassis. First, the

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proposed combination of Kalopissis and Clausen "would change the principle of operation" of Kalopissis, the primary reference. Second, Kalopissis expressly teaches away from the proposed combination.

The Office cites Kalopissis for a composition which contains at least one oxidation base in combination with at least one halogenated coupler of formula (I). Office Action, page 3, lines 1-2. The Office acknowledges that Kalopissis does not teach a pyrazole oxidation base. Office Action, page 3, lines 10-11. The Office cites Clausen for diaminopyrazoles used with conventional couplers to dye hair. Office Action, page 3, lines 15-16.

The Office concludes that "[i]t would have been obvious . . . to at least partially substitute the p-aminophenol oxidation base of Kalopissis . . . with diaminopyrazole . . . because Clausen teaches that the claimed diaminopyrazoles are an improvement over p-aminophenol." Office Action, p. 3, line 19 to p. 4, line 3. Applicants respectfully disagree because the Office's suggested combination is **directly counter to the express teachings** of the primary reference, Kalopissis.

First, Kalopissis specifically teaches that "[t]he dye compositions according to the invention are characterized by the following **essential features**... they **must** contain a paraphenylenediamine or a **paraaminophenol** or a heterocyclic oxidation base such as 2,5 diaminopyridine or 2-hydroxy-5-aminopyridine." Col. 2, line 67 - col. 3, line 5 (emphasis added). The above-cited teaching of Kalopissis is not directed just to a single embodiment of the invention, nor is it directed just to a set of preferred embodiments. Rather, Kalopissis' clear and unequivocal teaching of "essential features" refer to the "invention" as a whole.

Consequently, the Office's argument that "[i]t would have been obvious...to at least partially substitute the p-aminophenol oxidation base of Kalopissis... with diaminopyrazole" is insufficient to establish a *prima facie* case of obviousness because the combination is directly counter to the express teachings of Kalopissis that paraaminophenol (or another of Kalopissis' specifically identified bases) is a necessary element to the composition. That is, the Office's suggested combination **changes the principle of operation of Kalopissis**, by eliminating paraaminophenol, an "essential feature" of the reference. Therefore, as discussed below, there can be no motivation to make the proposed modification.

If a proposed modification of a reference destroys its intended function, then the requisite motivation to make the modification does not exist. See *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 n.12 (Fed. Cir. 1992) ("A proposed modification [is] inappropriate for an obviousness inquiry when the modification render[s] the prior art reference inoperable for its intended purpose."). Accordingly, when "the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified... the teachings of the reference are not sufficient to render the claims *prima facie* obvious." See M.P.E.P. §2143.01 (citing *In re Ratti*, 123 U.S.P.Q. 349 (CCPA 1959)). In the present case, removing an essential feature of Kalopissis is clearly changing its principle of operation, and, thus, the proposed combination fails to support a *prima facie* case of obviousness.

Second, Applicants respectfully submit that there could be no clearer case than the present case of a reference teaching away from a proposed combination. Specifically, the Office proposes "[i]t would have been obvious...to at least partially

substitute the p-aminophenol oxidation base of Kalopissis... with diaminopyrazole." However, Kalopissis specifically teaches away from such a proposed combination by stating that, rather than being amenable to substitution or elimination, paraaminophenol (or another of the specifically identified bases) is **essential** to the combination and **must** be present.

In *Winner Int'l Royalty Corp. v. Ching-Rong Wang*, 202 F.3d 1340, 53 U.S.P.Q.2d 1580 (Fed. Cir.2000), the Federal Circuit addressed similar facts of a reference teaching away from a proposed modification, and held that the invention was not obvious over the proposed modification. Winner's invention was a self-locking steering wheel anti-theft device using a ratcheting mechanism. The prior art Johnson patent used a dead-bolt which required a key. The prior art Moore patent described a ratcheting mechanism. The issue was whether there was any reason to substitute the more convenient ratcheting mechanism of Moore for the more secure dead-bolt of Johnson.

Winner argued that Johnson taught away from Moore. The Federal Circuit noted; "Trade-offs often concern what is feasible, not what is, on balance, desirable. Motivation to combine requires the latter." Citing *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994), the Federal Circuit found that the emphasis in Johnson's specification on security meant there was no motivation to combine it with Moore and thus replace the desired, secure dead-bolt with a more convenient ratcheting mechanism. For this reasons, the court held that the suggested combination failed to establish a *prima facie* case of obviousness.

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Similarly, the Office has proposed removing an essential feature of Kalopissis, and replacing it with different feature based on Clausen. However, just like *Winner*, given Kalopissis' emphasis on paraaminophenol as an essential feature, Kalopissis teaches away from this combination. There is no motivation or desire to combine it with Clausen and thus replace the essential paraaminophenol with diaminopyrazole, even if such replacement is feasible. For at least this reason, the suggested combination fails to establish a *prima facie* case of obviousness.

Finally, Applicants respectfully submit that the motivation attributed to Clausen has been misstated, and that, when clarified, further demonstrates that the Offfce's proposed combination of Clausen and Kalopissis fails to establish a *prima facie* case of obviousness. Specifically, the Office has argued, as motivation for the suggested combination, that "Clausen teaches that the claimed diaminopyrazoles are an improvement over p-aminophenol." Office Action, p. 3, line 19 to p. 4, line 3. More specifically, what Clausen teaches is that p-aminophenol is "criticized for not being physiologically tolerable" and that this problem is solved by use of formula (I) of Clausen. Col. 1, lines 43-65. Thus, rather than "**at least partially substitute** the p-aminophenol oxidation base of Kalopissis . . . with diaminopyrazole" (Office Action, p. 3, line 19 to p. 4, line 3 (emphasis added)), at best, the only logical combination and motivation based on Clausen is to **completely replace** the p-aminophenol oxidation base of Kalopissis with diaminopyrazole. Otherwise, if p-aminophenol is only partially substituted, the composition will, according to Clausen, still comprise the nonphysiologically tolerable base. That is, the problem to which Clausen (a physiologically tolerable composition) is directed will not have been solved. However,

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as discussed previously, Kalopissis is not amenable to the removal of p-aminophenol, which is specifically disclosed as an essential feature of the Kalopissis compositions. See Kalopissis, col. 2, line 67 - col. 3, line 5.

Applicants note that the argument that the suggested combination is contrary to Kalopissis, which teaches away from that combination, was previously submitted in Applicants Amendment of March 16, 2001, at p. 7, lines 1-15, but was not discussed in the most recent Office Action. Accordingly, it remains uncontested that the combination proposed by the Office is directly counter to the express teachings of the primary reference, Kalopissis. Therefore, should the rejection be maintained, Applicants respectfully would appreciate a clear explanation of the Office's position on this issue.

Reconsideration of the claims and withdrawal of the rejection is respectfully requested.

3. Double Patenting

Applicants acknowledge the rejection under the judicially created doctrine of obviousness-type double patenting as being unpatentable of U.S. Patent No. 6,090,162. Applicants respectfully request that the rejection be held in abeyance until there is an indication of allowable subject matter in the present application, at which time Applicants will file an appropriate terminal disclaimer.

CONCLUSION

Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims. The Examiner is invited to

contact the undersigned by telephone at (202) 408-4092 to address any remaining matters in this application.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: September 24, 2001

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